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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,717	02/29/2000	Binh T. Nguyen	IGT1P030/P-282	1099

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EXAMINER

SAGER, MARK ALAN

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/515,717

Applicant(s)
Nguyen

Examiner
Sager

Art Unit
3714



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 3, 2003
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 21-44 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 21-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

MARK SAGER
PRIMARY EXAMINER

Claim Objections

1. Claims 42-43 are objected to because of the following informalities: dependent upon canceled claim 14. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. Claims 1-13 and 21-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (6068552) in view of Kelly (6015344). This holding is maintained from prior action for cited claims, as amended, and is restated herein. Response to Applicant's assertions of patentability are provided below and incorporated herein. Walker discloses a gaming device and method for permitting player selection of prize from a list of prizes prior to each game play or outcome determination so the player inputs their preferences which encourages them to play longer thereby generating higher revenues for the casino due to the longer play session and less time for the player to be wandering in search of a game (1:5-7, 2:1-41; 3:10-11:42, esp. 3:40-11:20, figs. 1-12) teaching all claimed features/steps including memory storing a list of prizes cash, prize display mechanism displaying prizes stored in the memory, prize selection mechanism used to select prizes for game outcomes of a game played on a game machine with display wherein the prizes are cash and a server comprising an interface for providing information to gaming machines. Further, Walker teaches a gaming machine, a prize server, a prize distribution network and a method comprising a master gaming controller (figs. 1-12, ref. 102) to receive a wager (refs. 217-219, 316), to receive a prize selection (figs. 1-9b, ref. 312), to determine the outcome (4:2-10, figs. 1-12), to display the outcome and any prize awarded (4:2-10, 4:45-10:6, figs. 1-12), to award the selected prizes (3:35-4:12).

However, Walker does not disclose 'non-cash' prizes (clms 1, 14, 21, 24, 35), 'theme' (clm 13) 'merchandise, vacations, airline miles or shopping sprees' (clms 2, 15, 23, and 37), portable memory device is a personal digital assistant or smart card (clm 28), 'printing a record' (clm 41), 'prize fulfillment information used to redeem prizes won by players playing gaming machines' (clm 43) and a 'prize fulfillment center that is used to acquire and deliver prizes' (clm 44). This lack of disclosure does not teach away from claimed invention since the standard of patentability is what the prior art taken as a whole at a time prior to the invention suggests to an artisan. In this case, regarding claims 1-2, 14-15, 21, 23-24, 35 and 37, casinos offer or cater to player gaming preferences including prize preferences to attract them to play at their casino so as to increase their revenue thereby since the longer players continue to play the more the casinos' revenue is likely to increase (Walker, 1:5-40, 53-65). Player preferences include preferences for type of prize being either cash or non-cash winnings since some players prefer to receive cash payout while others prefer non-cash prizes as notoriously well known and as admitted prior art (instant background, 1:8-4:8, esp. 3:9-33 and page 5 of remarks filed Jan 14, 2002). Walker teaches system, method or machine to cater to player preferences including for amount of wager and size or amount of cash prize (2:1-41) in order to keep the casino's customers playing as long as possible since longer play generates higher revenues and doing this by providing players some perceived control over their game, but lacks disclosing non-cash prizes. Non-cash prizes, such as merchandise, vacations, airline miles or shopping sprees, are notoriously well known as 'theme' prizes having intrinsic monetary value which are monetarily equivalent prizes to the cash prizes taught by Walker. Applicant's admission in instant background that cash and non-cash prizes as

payout (1:7-4:8) such that some players are motivated to play dependent on preference for cash or non-cash prizes such as cruises or automobiles (3:12-13) and in remarks filed Jan 14, 2002 (page 5) is acknowledged. Kelly discloses a system, machine and method for player selection of prizes from a list of prizes stored in memory either on a gaming machine with a display for displaying the list of prizes or on a server having an interface for communication with gaming machines including wagering on games of chance (supra) teaching selecting prizes of cash (9:14-16, 9:61-10:2) and 'non-cash' prizes such as merchandise or shopping spree (9:61-10:5; 11:47-63, 24:62-25:32; 29:40-30:18, 32:31-47, figs. 1-15, esp. 6-6c and 9, or 32:31-46 for tournament play) from a selection menu (figs. 1-1a, 3-5b, 6-6c, 9-9a, 12-14) including 'theme' prizes (9:61-10:2, 11:47-63, 30:8-18) which include promotional awards by voucher or certificate for shopping spree at particular sponsor (11:47-61, 30:8-60, 32:31-47) where non-cash prizes are monetarily equivalent to cash prizes due to their intrinsic cash value to cause greater interest and involvement and thus increases the games earnings thereby (24:16-19) by allowing players to view and select cash or non-cash prizes (9:61-10:2, 20-23). Kelly further teaches awarding non-cash prize or monetary equivalent amount for shopping spree (34:49-57). Therefore, it would have been obvious to an artisan at time prior to invention to add 'non-cash' selected from the group of 'merchandise, vacations, airline miles, shopping sprees' and 'theme' as notoriously well known by Applicant's admissions (supra) or as monetarily equivalent or as taught by Kelly to Walker's game device and method to provide alternate equivalent payout or to motivate players to play longer by providing prizes of players' personal preference (Applicant's admission) or to cause greater interest and involvement and thus increases the games earnings thereby (Kelly, 24:16-19) by

allowing players to view and select cash or non-cash prizes (Kelly, 9:61-10:2, 20-23). Kelly further teaches acquisition, management, distribution and accounting of the non-cash prizes (35:31-61:42, figs. 9-15). In addition, it is noted that Kelly is analogous prior art for being either in the Applicant's field of endeavor or reasonably pertinent to the particular problem with which the applicant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this instance, Walker discloses a gaming device and method for prize selection but lacks non-cash prizes such as merchandise, vacations, airline miles, or shopping sprees. Non-cash prizes are monetarily equivalent to cash prizes taught by Walker (*supra*). Further, Applicant's admission that some players are motivated to play dependent on preference for cash or non-cash prizes such as cruises or automobiles (3:12-13) and in remarks filed Jan 14, 2002 (page 5) is noted. Finally, Kelly discloses a prize system (3:29-5:41, 6:55-61:43, figs. 1-15) teaching selection of cash and non-cash prizes such as merchandise or shopping sprees to cause greater interest and involvement and thus increases the games earnings thereby (24:16-19) by allowing players to view and select cash or non-cash prizes (9:61-10:2, 20-23). Kelly further teaches acquisition, management, distribution and accounting of the non-cash prizes on the prize server and associating payout with hit ratio of game and cost associated with non-cash prizes (35:31-61:42, esp. 35:31-45:67, figs. 9-15, refs. 470, 472, 474, 476, 478, 480, 482) which is analogous to formulas for calculating the cash prizes and hit ratios within Walker. Further, Kelly is analogous prior art for being in the field of games including wagering on games of chance having prize selection from a list of prizes and a prize distribution center for acquiring, managing and delivering prizes awards or Kelly is reasonably pertinent to the particular problem with which the

Applicant was concerned for providing a gaming machine, server/network or method for allowing players to select prizes including cash and non-cash from prize list and for distributing those prize awards (supra). Therefore, Kelly is analogous prior art.

Further, regarding personal digital assistant or smart card (clm 28), 'printing a record' (clm 41), 'prize fulfillment information used to redeem prizes won by players playing gaming machines' (clm 43) and a 'prize fulfillment center that is used to acquire and deliver prizes' (clm 44), Kelly teaches portable memory device is a magnetic card, personal digital assistant or smart card to allow transfer of stored selected prizes to be recorded onto portable magnetic media so as to allow prize claim at another or remote location by card reader (11:20-23; 15:66-16:5; 17:16-20, 39-58; 28:39-63), 'printing a record' (11:64-12:21), 'prize fulfillment information used to redeem prizes won by players playing gaming machines' (28:39-63, figs. 1-15) and a 'prize fulfillment center that is used to acquire and deliver prizes' (28:39-63, figs. 1-15) for stocking and delivering non-cash prizes. Kelly also teaches accounting or adjusting probability based in part on the intrinsic cash value of the non cash prizes (figs. 9-15). Therefore, it would have been obvious to an artisan at a time prior to the invention to add personal digital assistant or smart card, 'printing a record', 'prize fulfillment information used to redeem prizes won by players playing gaming machines' and a 'prize fulfillment center that is used to acquire and deliver prizes' as taught by Kelly to Walker's gaming device and method to allow prize claim of player selected non-cash prize at another or remote location having a reader and to stock and deliver non-cash prizes.

Therefore, in this instance, when the prior art is taken as a whole at a time prior to the invention, Walker in view of Kelly and admitted prior art suggests to an artisan a gaming machine, server, network or method, as claimed, permitting player selection of either cash or non-cash prizes (which have an intrinsic monetary value that is monetarily equivalent to cash prizes or provided to cater to player preference) based on the players' preference so as to encourage players to continue to play longer which generates increased revenue for the casino from the longer play session.

Response to Arguments

3. Applicant's arguments filed ^{1/31/2003} ~~June 19, 2002~~ have been fully considered but they are not persuasive. First, Walker discloses a gaming machine, server configured for each played game of chance 1) to receive a selection of a prize from a list of prizes *prior* to determining the outcome of a played game of chance wherein the prize corresponds to an award for at least one outcome for the played game of chance and wherein the prize is only awarded after the outcome of the played game of chance is determined (4:65-11:42, figs. 1-12, esp. 4A-4B, 9A-9B, ref. 312, steps 912-934), 2) determine the outcome for the played game of chance and 3) display the outcome for the played game of chance and 4) indicate an award of the prize when the determined outcome for the played game of chance is the same as the at least one outcome for the played game of chance corresponding to the prize each (figs. 1-2, 7-810-12, refs. 232, 234, 236 of 210, 510, 710, 810). mal

In response to Applicants' remark that in Walker, 'the player has no choice in regards as to what type of prize is awarded' and that Walker teaches 'odds selection not prize selection' is incorrect in so far as type of award includes cash prize or cash level. Walker teaches that the

player may decide the prize for each game outcome where the prize is cash prize level (*supra*). Where type of prize further includes distinguishing between a cash prize or a non-cash 'cash equivalent' prize, a non-cash prize inherently has a cash equivalent as taught by Walker. Thus, Walker's system is equivalent to claimed invention from its inherent cash equivalent award. However, further, regarding Applicant's assertion that Walker does not suggest any non-cash prizes, it is noted that the holding is obviousness under 103 rather than anticipation and the standard of patentability remains as to what the combination of prior art taken as a whole at a time prior to the invention suggests to an artisan. In this instance, in consideration of Applicant's admission that some player prefer cash prize awards while others prefer non-cash prize awards (*supra*), Kelly's system for player selection of cash and non-cash prize awards from a menu list of prizes and Walker's teachings to maintain player interest and excitement with regards to slot machine play since longer play generates higher revenues for casinos and players generally are more likely to be interested in something over which they have some control (1:10-65; 2:1-41), the combination when taken as a whole at a time prior to the invention suggests to an artisan a gaming machine, prize distribution network, prize server or method to receive a [player] selection of prize from list of prizes prior to determining outcome of each play of a game of chance, determine the outcome of the played game, display the outcome of the played game and indicate an award of the prize when the determined outcome of the played game is the same as the at least one outcome for the played game corresponding to the prize where the prize is selected from cash and non-cash prizes.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation comes, as stated above and incorporated herein, from the knowledge generally available to one of ordinary skill in the art that player's have preference regarding cash and non-cash prize awards (*supra*), from Kelly (24:16-19) to cause greater interest and involvement and thus increases the games earnings thereby and from Walker's suggestion that a casino's goal is to keep customers playing as long as possible since longer play generates higher revenues and that players generally are more likely to be interested in something over which they have some control (Walker, 1:10-41, 53-65, 2:1-41). An artisan of gaming with the general knowledge of player preferences regarding types of prize awards and with Kelly's system for providing a menu for prize selection including cash and non-cash prizes, would have been motivated at a time prior to the invention to add non-cash to Walker's device and method to keep its customer's playing as long as possible so as to generate higher revenues in part by providing players some control so they may select their preference regarding prize award. The suggestion for combination is as stated above incorporated herein due to equivalence of prize value, in consideration of admissions of known to preferences of players regarding cash and non-cash prizes (*supra*) with further consideration of Kelly's teachings for player selection of cash or non-

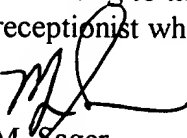
cash prize(s) to cause greater interest and involvement and thus increases the games earnings thereby (24:16-19) and consideration that a casino's goal is to maintain player interest and excitement thereby increasing casino profits and that players generally are more likely to be interested in something over which they have some control (Walker, 1:10-41, 53-65).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. S. Tom Hughes, can be reached on (703) 308-1806. The fax phone number for this Group is (703) 872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.


M. Sager
Primary Examiner
Mar. 13, 2003